

REMARKS

Claims 1, 8 and 12 have been amended. New claim 22 has been added. Claims 1-20 and 22 are pending in the present application. Applicant reserves the right to pursue the original claims and other claims in this application and in other applications.

Claims 1-4 and 6-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by newly cited Miller (U.S. Patent no. 7,035,809). The rejection is respectfully traversed.

Claim 1 recites a method for creating a workflow process management application suitable for an organization. According to claim 1, the "workflow process management application, when executed by said computer, permits a user to: enter, for each department, a workflow plan for said department, receive a workflow performed by departments of said organization, and create a report comparing said workflow plan with said workflow performed." Claim 1 further recites that "said workflow process management application [uses] said report to automatically generate subsequent worker assignments without further interaction with the user." Applicant respectfully submits that Miller fails to disclose, teach or suggest the claim 1 invention.

Miller by contrast is directed to a "method for assisting and expediting an organization's progression through the levels of the Capability Maturity Model (CMM). Specifically, the [Miller] invention relates to a method and related system for arranging and administering an organization's infrastructure and a project of interest so that the organization and the product may be more mature, as measured by the CMM." Miller Col. 1, ll. 6-12. Miller is designed to produce an organization plan 1140 (Miller FIG. 11A). This is entirely different than the claimed invention's workflow, which refers to

both work (i.e., activities) that must be performed as well as the resources required to perform the work.

Moreover, the entirety of the Miller reference relates to multiple process steps and flowcharts designed at meeting the CMM goal. Almost all of these processes require offline managerial and/or other forms of external review. *See e.g.*, Miller Col. 7, l. 56 to Col. 8, l. 1 (project management is expected to take appropriate action); Col. 8, ll. 32-48 (the “implementing organization may further obtain approval for corrective actions, and then take corrective actions”); Col. 8, l. 58 to Col. 9, 2 (“Another scope management task is requirements acceptance, during which the organization documents and reviews requirements with all affected groups and obtains acceptance from the affected stakeholders.”); Col. 10, l. 46 to Col. 11, l. 18 (listing multiple issues to be referred to program/senior management for handling/correcting).

In addition, according to a portion of Miller relied upon by the Office Action as teaching this “automatic” limitation, Miller states:

During the control of SEPG project work in the step 230, SEPG project management monitors the execution of the project against project plan and makes adjustments as necessary. Project Status Reports are prepared for the Project Sponsor. Potential and actual problems are identified through the measuring and monitoring of progress and performance against the SEPG Project Plan. Depending on the type of problem identified, an Issue, Risk, System Investigation Request (SIR) or Change Request (CR) is logged. The SIRs and the CRs are described in greater detail below. SEPG Project management is expected to take appropriate corrective actions to resolve problems that are discovered.
Miller Col. 7, l. 56 to Col. 8, l. 1 (emphasis added).

Accordingly, it is clear from the description throughout the Miller reference, there is no capability in Miller for, or disclosure of, a “workflow process management application using said report to automatically generate subsequent worker assignments without further interaction with the user.” This feature is simply not found in Miller.

Applicant acknowledges that Miller does disclose a computer implementation whereby a computer application:

prompts an organization for various inputs regarding its operation and structure. Using these inputs, the application then creates a series of task lists to implement the APIF method 10 of the present invention. The application may further create a record of task lists, so that the organization may easily document its actions as required in the CMM and CMMI. Alternatively, the program may provide templates through which the organization may document its activities.

Miller Col. 59, ll. 37-46.

Applicant respectfully submits that templates and task lists are not automatic features allowing the computerized implementation of Miller’s methods to generate subsequent worker assignments automatically based on a report and without user interaction. Miller’s Figure 11A is described as a computer application of the Miller processes and flowchart steps. According to Miller, the FIG. 11A system 1100 is capable of receiving a user input 1130 and producing a business organization plan 1140 based on the user input 1130. Nowhere in this portion of Miller, or in any of the portions relied on in the Office Action, is there a disclosure of a “workflow process management application using said report to automatically generate subsequent worker assignments without further interaction with the user.” As such, Applicant respectfully submits that the claimed invention is allowable over Miller.

Claims 2-4 and 6-7 depend from claim 1 and are allowable along with claim 1. Claim 8 similarly recites that "said workflow process management application uses said report to automatically generate subsequent worker assignments without further interaction with the user." Accordingly, claim 8 is allowable over Miller for at least the reasons set forth above and on its own merits. Claims 9-11 depend from claim 8 and are allowable along with claim 8.

Claim 12 similarly recites that "said workflow process management application uses said second report to automatically generate subsequent worker assignments without further interaction with the user." Accordingly, claim 12 is allowable over Miller for at least the reasons set forth above and on its own merits. Claims 13-14 depend from claim 12 and are allowable along with claim 12.

Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller. The rejection is respectfully traversed. Claim 5 depends from claim 1, which as set forth above, is allowable over Miller. Applicant respectfully submits that claim 5 is allowable along with claim 1 and that the rejection should be withdrawn and claim 5 allowed.

Claims 15-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Flores (U.S. Patent no. 5,734,837). The rejection is respectfully traversed.

Claims 15-20 depend from claim 1, which as set forth above, is allowable over Miller. Applicant also submits, however, that Flores, which has been cited as allegedly teaching specific features missing from Miller (e.g., displaying a page in a user

interface, creating objects based on user events, etc.), does not rectify the above-noted deficiencies of Miller. For example, and as successfully argued in a prior amendment, Flores fails to disclose, teach or suggest a “workflow process management application, when executed by [a] computer, permits a user to: . . . create a report comparing said workflow plan with said workflow performed; [where] said workflow process management application [uses] said report to automatically generate subsequent worker assignments without further interaction with the user.”

Flores, by contrast, merely discloses observing the status of a transaction via status reports. Flores does not elaborate what these status reports contain. Flores does not disclose or suggest the ability to “create a report comparing said workflow plan with said workflow performed” or the ability for the application to use the “report to automatically generate subsequent worker assignments without further interaction with the user.” As such, Flores fails to disclose, teach or suggest this feature, which is also missing from Miller. Accordingly, the claims are allowable over the cited combination for at least this reason.

Moreover, Flores fails to teach or suggest how to modify Miller to obtain the claimed invention. There is therefore no *prima facie* case of obviousness. Obviousness is based on factual findings. “Whether a patent claim is obvious under section 103 depends upon the answer to several factual questions and how the factual answers meld into the legal conclusion of obviousness *vel non*.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). The four underlying factual inquiries are: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the pertinent art; and (4) secondary considerations, if any, of non-obviousness. *Graham v. John Deere Co.*, 393 U.S. 1, 17-18 (1966).

Applicant respectfully submits that there is no motivation to combine the cited references to obtain the invention of claims 15-20. Motivation or suggestion to combine or modify prior art references "must be clear and particular, and it must be supported by actual evidence." *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334 (Fed. Cir. 2002). Because the "genius of invention is often a combination of known elements which in hindsight seems preordained," the Federal Circuit requires a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *McGinley*, 262, F.3d at 1351. Yet there is no teaching or suggestion within any of the references that provide a motivation to combine them.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Thus, a showing of an obvious combination requires more than just an amalgam of references, each of which provides one feature of the claimed invention.

The Office Action has done no more than cite a pair of references, each of which allegedly provides only part of the claimed invention, and allege that their combination renders the invention obvious. However, without the benefit of hindsight, there would have been no motivation to combine these references and the Office Action has failed to provide proof of any such motivation. This is one more reason why claims 15-20 are allowable over the cited combination.

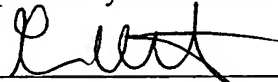
Applicant respectfully submits that the rejection should be withdrawn and the claims allowed.

New claim 22 has been added to round out the scope afforded the invention and is believed to be allowable for at least the reasons set forth above with respect to the other independent claims.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

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